

REMARKS

This paper is filed in response to the office action mailed on January 22, 2007.

I. Status of the Amendments

Prior to this amendment, claims 1 – 12 and 17 – 31 were pending. By this amendment, all independent claims (1, 21, 24, and 28) have been amended. No claims were canceled. Consequently, claims 1 – 12 and 17 – 31 are still presently pending.

II. Response to January 22, 2007 Office Action

The office action rejects claim 31 under 35 U.S.C. §112, ¶1 as reciting subject matter not described in the specification. Applicant respectfully traverses and directs the examiner to the discussion at paragraph [0118] of the application, which specifically describes that in some systems “a gaming machine [may be] configured to issue a ticket or receipt to a player [where a] player’s picture may be printed upon such a ticket,” thus showing that the was clearly in possession of the recited subject matter at the time of filing. The rejection is respectfully traversed.

Claims 1 ,3 – 12, 17 – 20, and 24 – 30 stand rejected under 35 U.S.C. §103 based on a new suggested combination of DeBan and Yoshida. Claims 2 and 21 – 23 also stand rejected under 35 U.S.C. §103 based on the same alleged combination of DeBan and Colbert offered in the last office action.

The Finality of the Rejection is Improper and Must be Removed

As an initial matter, because the examiner has levied a new rejection of previously un-amended claims, the finality of this action is in error and a new non-final rejection must be entered. In the immediately preceding office action (dated February 7, 2006), the examiner rejected independent claim 24 based on a purported combination of DeBan, Yoshida, and a third reference, Alden. See, 2/7/2006 Official Action, page 2. On May 8, 2006, applicant filed a response to the office action which resulted in certain claims being amended, but not independent claim 24. That claim was not amended. The present office action rejects claim 24 based on a new rejection, of DeBan and Yoshida only. Because this rejection was not precipitated by the applicant, the rejection cannot be made final.

A new, non-final office action must be issued by the patent office.

In addition to the finality of the office action being improper based on the new, unprovoked grounds for rejection, the finality is improper because the office action has failed to address claim 31 on the merits.

Response to the Prior Art Rejection

As to the substance of the rejections, applicant reiterates what is now even more apparent from the present office action, that the office has failed to establish *prima facie* obviousness. Pages 8 – 10 of the office action in fact show that the not even the patent office believes the prior art teaches all of the recited subject matter.

Take the rejection of claim 1, for example. As the applicant previously showed, neither DeBan or nor Yoshida individually teach automatically initiating interior image collection in a gaming machine or other device in response to user interaction with a peripheral of that device. The office action responds that while this is true, the prior art, namely Yoshida, teaches the equipment needed to do so; therefore, claim 1 would have been obvious. See, paragraph spanning the bottom of page 8 to the top of page 9 of the office action. This rationale is of course not a sufficient grounds for an obviousness rejection, otherwise a great many inventions that are combination of known elements or made with known elements would be held *per se* unpatentable.

To establish *prima facie* obviousness, an office action cannot rely upon the mere fact that references can be combined or modified. MPEP §2143.01, citing *In re Mills*, 916 F.2d 860 (Fed. Cir. 1992). Nor may an office action maintain a rejection based on the notion that the claimed subject matter was within the capabilities of one of ordinary skill in the art. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993) (stating that a rejection that the claimed inventions would have been well within the ordinary skill of the art at the time the invention was made is not sufficient to establish a *prima facie* case of obviousness).

In *KSR International Co. v. Teleflex Inc.*, the Supreme Court addressed the standard for obviousness, and specifically the teaching, suggestion, motivation TSM test of the Federal Circuit. *KSR v. Teleflex*, No. 04-1350 (U.S. April 30, 2007). While the Court held that TSM test, though proper, may not be rigidly applied as required for obviousness, the Court did not abandon the requirement that the prior art when combined must still teach all elements of the

claimed subject matter. See, e.g., May 3, 2007 letter of Margaret Focarino to the Technology Center Directors; MPEP 2143.03.

Therefore, where as is the case here the prior art when combined would not teach all of the recited elements, an obviousness rejection cannot be sustained. MPEP 2143.03. The office action's position that it would have been within the purview of persons of ordinary skill in the art to take the alleged combination, that itself does not teach the recited subject matter, extend that combination until the recited subject matter was achieved is hindsight use of the applicant's own disclosure.

In fact, the prior art in this case provides a working example of why such hindsight examination is so problematic. The same Yoshida reference that the office action describes as having the equipment necessarily to achieve the recited subject matter expressly teaches away from using that equipment in the manner recited in claim 1. Yoshida teaches that fault detection information collected at the ATM must be first communicated to a remote supervising controller, where the type of fault must be determined, before a corresponding remote command may be sent to the ATM for camera initiation. See, e.g., Yoshida 3:41 – 4:8, and Fig. 3. Thus, Yoshida does not automatically initiate camera operation based on user interaction, but rather polls a remote supervisor to manually initiate such operation, in essence teaching away from a gaming machine that has an image collection device “associated with at least one peripheral of the gaming machine for automatically collecting the at least one image associated with the interior of the gaming machine in response to interaction with the at least one peripheral of the gaming machine,” as recited in claim 1.

Thus, setting aside the question of whether the office action has set forth a sufficient rational for combining the DeBan and Yoshida, the alleged combination could not render the claimed subject matter obvious.

Although the foregoing provide sufficient basis for overcoming the rejection of claim 1, applicant has amended the claim to further define over the art by distinguishing that the peripheral capable of automatically initiating image capture upon user interaction is also capable of communicating the act of user interaction remotely, as generally discussed in paragraph [0014] of the present application. This dual capability allows the gaming system to not only immediately initiate image capture, but notify a remote location, such as a control

system or monitor, of the specific type of interaction. Specifically, claim 1 has been amended as follows:

A method of authorizing use of a card in a gaming machine located in a casino and collecting security data regarding activities occurring at or associated with an exterior and an interior of the gaming machine, the method comprising:
generating first facial image information regarding a person;
storing said first facial information on a card issued to said person;
reading said first facial image information stored on said card at said a gaming machine in said casino;
obtaining current facial image information of a person using said card at said gaming machine;
comparing said first facial image information stored on said card with said current facial image information of said person at said gaming machine using said card to confirm that the person using said card is the party to whom the card was issued; and
providing at least one image collection device for obtaining at least one image of an activity associated with the interior of the gaming machine, wherein the at least one image collection device is associated with at least one peripheral of the gaming machine, wherein the at least one peripheral device is associated with a communication link for communicating user interaction with the peripheral to a remote location and where the peripheral device is coupled to the at least one image collection device for automatic collection of the at least one image associated with the interior of the gaming machine in response to interaction with the at least one peripheral of the gaming machine, wherein the at least one image collection device is also for obtaining the at least one image of the activity associated with the interior of the gaming machine simultaneously with the obtaining of the current facial image information.

Claim 1 and the claims depending therefrom are in condition for immediate allowance.

With respect to claim 21, the office action concedes that the prior art does not teach (1) generating security data indicating an alarm condition when the gaming machine is unable to capture current facial image information and (2) communicating that security data to a remote location. Applicant has further amended claim 21 to recite that the triggering event is

user interaction with a peripheral that, similar to claim 1, is capable of separately communicating the act of user interaction to a remote location.

For the foregoing reasons, the rejection of claim 21 and the rejections of claims 22 and 23 depending therefrom are respectfully traversed.

Independent claim 24 has also been amended and now recites that the first facial image information is generated in response to a user interacting with a peripheral coupled to a remote location through a communication link. Therefore, for the foregoing reasons, the rejection of claim 24 and claims 25-27 depending therefrom are traversed.

With respect to claim 28, applicant previously discussed that DeBan did not disclose an initial trigger event occurring prior to or upon initiation of a game on the gaming machine and a second triggering event occurring during execution of the game on the gaming machine, where facial image information would be captured both times for comparison. The office action responds that although DeBan indeed does fail to teach such subject matter, “in the scope of gaming machines, it is taught by DeBan. . .to run the identification and verification process again when a payout occurs.”

By invoking the phrase “in the scope of gaming machines” the office action suggests that DeBan pertains to something it does not. DeBan relates to ATMs, not gaming machines. To suggest that DeBan irrespective of what it states on its face, has some implicit, undescribed but inherent other teaching that would come to light if the reference were to be applied to the gaming machines art is an attempt to infuse DeBan with what hindsight would hope it to teach. The question is what does the prior art teach, alone or in combination, not what it could teach in a totally different context. This is one of the many reasons why inherency cannot be argued based on possibility.¹ The office action has failed to make any showing that the alleged prior art combination teaches or suggests the recited subject matter. For these reasons, the rejection of independent claim 28 is traversed.

Although the foregoing provide sufficient basis for overcoming the rejection of claim 28, applicant has amended claim 28 to recite the subject matter of the claims depending

¹ As the MPEP provides, for a teaching to be argued as inherent, that teaching must necessarily be present in the single prior art disclosure. See, e.g., *Electro Medical Systems, S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048 (Fed. Cir. 1994). Courts do not allow inherency challenges based on mere possibility or conjecture. “The mere fact that a certain thing may result from a given set of circumstances is insufficient to prove anticipation.” *Electro Medical Systems, S.A., v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 1052 (Fed. Cir. 1994).

Application No. 10/660,879
Amendment dated May 22, 2007
After Final Office Action of January 22, 2007

Docket No.: 29757/P-276-DIV

therefrom, including claim 31 which does not stand rejected on prior art grounds. Claim 28 is therefore in condition for allowance in light of the additional recitations of these claims.

In view of the above amendment, applicants believe the pending application is in condition for allowance.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Dated: May 22, 2007

Respectfully submitted,

By 

Paul B. Stephens

Registration No.: 47,970

MARSHALL, GERSTEIN & BORUN LLP

233 S. Wacker Drive, Suite 6300

Sears Tower

Chicago, Illinois 60606-6357

(312) 474-6300

Attorney for Applicant